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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,817

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Ryuichi Kurata

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EXAMINER

NEWAY, BLAINE GIRMA

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

07/08/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/598,817

Applicant(s)

KURATA ET AL.

Examiner

BLAINE G. NEWAY

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 9/12/06 & 07/02/09

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3-4 and 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 6- 7 recite the limitation "said enclosing medium holder". It is unclear which of the enclosing medium holders claimed in independent claim 1 is being recited.

In claim 4, it is unclear which parts (the enclosing media or the enclosing medium holders) are enclosed in the outer casing and also it is unclear which parts overlap each other.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kohana (US 2002/0179475).

In re claim 1: Kohana discloses an enclosing casing having a combination of:

an outer casing B having an inserting port in one side portion; and
an inner casing (i.e. combination of multiple unit case A) inserted and ejected into/from outer casing B through the inserting port; in which both the outer casing B and inner casing are formed by folding a paper material, wherein the inner casing is constructed by enclosing medium holders or unit cases A which overlap each other so as to be relatively movable (figures 10-11; and paragraphs 0083 and 0091).

In re claim 2: Kohana further discloses the enclosing medium holders A being reciprocatively moved in almost the same direction when inserted and ejected into and from outer casing B (figure 11).

In re claim 3: Kohana further discloses a restricting portion (i.e. the bottom portion of inner casings A) to restrict a positional deviation of an enclosing medium C being provided for the enclosing medium holders A (figure 11).

In re claim 4: Kohana further discloses the outer casing B being formed by a box having an internal volume in which all of the enclosing medium holders A holding enclosing media C can be enclosed in outer casing B so as to overlap each other (figure 11).

In re claim 5: Kohana further discloses retaining portions 5-7 hooked with each other (to prevent mutual separation of the enclosing medium holders A), being provided in portions where enclosing medium holders A overlap each other (figures 10-11).

In re claim 6: Kohana further discloses retaining portions 4 and 20 hooked with each other (to prevent separation of outer casing B and one of the enclosing medium holders A), being provided in portions where the outer casing B and one of the enclosing medium holders A overlap (figures 10-11 and paragraph 0098).

In re claim 7: Kohana further discloses a lid portion which closes the inserting port when all of the enclosing medium holders have been enclosed in the outer casing B being provided (paragraph 0092).

In re claim 9: Kohana further discloses a lid portion (to cover the outer casing opening) which closes the inserting port in after all of the enclosing medium holders have been enclosed in the outer casing B (paragraph 0092).

In re claim 10: Kohana further discloses the enclosing medium holders A overlapping in a telescopic form (figure 11).

In re claim 11: Kohana further discloses a gap (larger than a thickness of an enclosing medium C capable of being held in one of the enclosing medium holders C) existing between an outermost enclosing medium holder C and an adjacent inside enclosing medium holder C which is inserted into an outermost enclosing medium holder C (figures 10-11).

In re claim 12: Kohana further discloses a tab 2a being provided for an edge portion of the enclosing medium holder A which faces the inserting port in when the enclosing medium holders A have been enclosed in the outer casing B (figures 10-11).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kohana (US 2002/0179475) in view of Jang (US 2003/0000854).

Kohana further discloses the lid portion being provided for closing the opening or the inserting port of the outer casing (i.e. for closing the enclosing medium holders), and to wrap or enclose the enclosing medium holders but fails to disclose the following limitation which is taught by Jang:

a front edge portion 33 of a lid portion being folded and inserted into an opening or an inserting port (figure 4b).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have inserted the lid portion of the device of Kohana in the inserting port as taught by Jang, for the predictable result of keeping the

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casing closed until the enclosing medium holders are pulled out, to prevent accidental opening of the casing.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are casings analogous to Applicant's instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLAINE G. NEWAY whose telephone number is (571)270-5275. The examiner can normally be reached on M-F 7:30 AM- 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on 571 272-4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JILA M MOHANDESI/
Primary Examiner, Art Unit 3728

BGN

7/2/2009